

REMARKS

Assignee and the undersigned attorney thank Examiner Chang for his review of this patent application. In the above amendment, claim 1 is amended. Claims 9-19 have been withdrawn from further consideration under 37 C.F.R. § 1.142(b) as being drawn to a non-elected invention. Assignee respectfully requests reconsideration of pending claims 1-8.

Claim Rejection Under 35 U.S.C. § 112

The Action rejected claims 1-8 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Action states that the phrase “bonded . . . without the use of . . . laminations” is indefinite and confusing. The Action asserts that the first foam layer and bonded second foam layer are inherently a laminated structure and that “laminations” is a structural relationship between layers not a material for bonding as are “adhesives” and “bonding agents.” Assignee has amended claim 1 to remove the reference to “laminations.”

However, Assignee disagrees that “lamination” refers only to a structure or structural relationship. “Lamination” often refers to the process of joining two or more layers together, with or without an adhesive, typically by applying pressure to the layers. For example, at column 2, lines 30-32 of U.S. Patent No. 4,806,404 to *Cascino*, the disclosure describes a

PVC foam “laminated” to polyethylene foam with an acrylic adhesive on one side by “passing [the foams] through nip rollers.”

Claim Rejections Under 35 U.S.C. § 103

The Action rejected claims 1-6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,806,404 to *Cascino* (“*Cascino* ‘404’”) in view of U.S. Patent No. 5,328,937 to *Cascino* (“*Cascino* ‘937’”) and further in view of U.S. Patent No. 3,852,389 to *Adler et al.* (“*Adler*”). The Action rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Cascino* ‘404, *Cascino* ‘937, and *Adler*, and further in view of U.S. Patent No. 3,616,029 to *Lerman* (“*Lerman*”).

Claim 1 recites:

A spacer suitable for use in separating smooth surfaces of adjacent pieces of fragile material, comprising:

a first foam layer with a tendency to cling to smooth surfaces;

and

bonded to the first foam layer to form a single structure without the use of adhesives or other bonding agents, a second foam layer having a higher density and a lower tendency to cling to smooth surfaces than the first foam layer.

Cascino ‘404 teaches a spacer member 12 with a first base layer 14 and a second tack layer 16. In the only example spacer described in *Cascino* ‘404, an acrylic adhesive is applied to the base layer (closed cell polyethylene) and the tack layer (PVC-plasticizer foam) is then laminated to the base layer by passing both layers through nip rollers. *See* col. 2, lines 28-32.

Cascino '937 simply teaches that one may substitute a foamable PVC resin for the base layer (or cork layer) in a spacer such as the one described in *Cascino '404*. *Cascino '937* teaches that this cork-replacing foam layer is laminated to the tack layer or otherwise adhered to a surface. See Abstract.

The background of the present application describes conventional spacers, such as those taught by *Cascino '404* and *Cascino '937*, that require an additional adhesive layer between the base layer and the tack layer of the spacer. In contrast to these spacers, the present application teaches one or more embodiments of a spacer in which the first and second foam layers are bonded together to form a single structure without the use of any adhesive or other bonding agent. See paragraphs 7, 8, 19, and 20 of US2003/0035942 (the published version of the present application). It is clear that *Cascino '404* and *Cascino '937* do not teach or suggest a spacer with first and second foam layers bonded to form a single structure without the use of adhesives or other bonding agents, as recited in claim 1.

To overcome the deficiency of these two references, the Examiner attempts to combine *Adler* with *Cascino '404* and *Cascino '937* in asserting that claim 1 is obvious. The Examiner states that *Adler* teaches a method of making a PVC plastisol foam body by heat foaming a two-layered structure that is fused together to form an integral foam body. However, the combination of *Adler* with *Cascino '404* and *Cascino '937* is improper because

Adler is nonanalogous art and there is no motivation or suggestion to combine these references as suggested by the Examiner.

Adler is nonanalogous art that cannot be properly relied upon in rejecting claim 1 under 35 U.S.C. § 103. See MPEP § 2141.01(a). “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). There is no question that *Adler*, which is directed to a method of making and shaping foam plastic dolls that have lifelike outer skins, is not in the field of applicants’ endeavor, the field of spacers for separating fragile materials.

Nor is *Adler* reasonably pertinent to the problem with which the inventors were concerned. A reference is reasonably pertinent only if “it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). *Adler* is not such a reference. *Adler* describes a complex process for forming foam dolls using a mold and specific combinations of heat and pressure such that the outer skin of the doll is more lifelike than existing dolls. *Adler* would not have logically commended itself to inventors seeking to solve the problems associated with using cork and cork substitutes in spacers for fragile objects that are described in the background of the present application.

Additionally, similarities in structure and function carry great weight in determining whether a particular reference is nonanalogous. *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973); *see* MPEP § 2141.01(a). *Adler* teaches foam plastic dolls with an integral outer skin formed around a human-shaped interior body. *Cascino* '404, *Cascino* '937, and the present application describe sandwich structures suitable for use as spacers used between fragile objects. The two-layer structure of *Adler* can only be created using a detailed mold and applying varying levels of pressure during the process such that one layer forms a lifelike outer skin and the second layer forms an interior body. Making the outer skin lifelike is the primary focus of *Adler*. *Adler* describes a toy. Such a plastic foam doll toy is not suitable to function as a spacer between fragile objects. The structure and function of *Adler* is very dissimilar from the structure and function of the spacers described by the other cited references and the present application.

For the above reasons, *Adler* is nonanalogous art that cannot be properly combined with *Cascino* '404 and *Cascino* '937 to reject claim 1 as obvious under 35 U.S.C. § 103.

Additionally, a *prima facie* case of obviousness requires some suggestion or motivation in the art to combine the references. MPEP § 2143. The Examiner's asserted motivation for combining *Adler* with *Cascino* '404 and *Cascino* '937 is "the desire to obtain a fused integral foam structure for a strong bonding between the two layers." *Cascino* '404 discloses a two-foam structure where the foam layers are laminated together. Despite using

two foams and indicating that “any material sufficient to provide a backing for layer 16 which does not scratch glass panels may be used to form layer 14,” *Cascino* ‘404 does not suggest a bonding problem between the foam layers that provides one with the desire to make a fused integral foam structure. *Cascino* ‘937 discloses a foam substitute for cork that, according to the Examiner, may be laminated to the foam tack layer of *Cascino* ‘404 to form a spacer. Once again, despite allegedly teaching a two-foam structure for a spacer, *Cascino* ‘937 does not suggest that a two-foam structure bonded without adhesive would be desirable because of some bonding problem between the layers. In fact, *Cascino* ‘937 teaches away from bonding the described PVC foam to a foam tack layer because *Cascino* ‘937 describes that the foam is rolled up and sold independently as a cork substitute. Col. 2, lines 43-44; col. 3, lines 6-7. To “fuse” the PVC foam of *Cascino* ‘937 to a tack foam layer as an integral structure during processing would limit the potential of the PVC foam to be sold independently as a cork substitute, which would not be desirable.

Adler does not provide the requisite motivation either, as its chief objective is to achieve a lifelike outer skin for a foam doll using a mold. Notably, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Examiner has not shown the requisite motivation for combining *Adler* with

Cascino '404 and *Cascino '937* existed at time of the invention claimed in the present application.

For the above reasons, the combination of *Cascino '404*, *Cascino '937*, and *Adler* suggested by the Examiner is not proper. Thus, the § 103(a) rejection of claim 1 should be withdrawn, and claim 1 should be allowed. Inasmuch as claims 2-8 depend from and thereby include the limitations of claim 1, claims 2-8 should also be allowed for at least such dependencies.

The foregoing is submitted as a full and complete response to the Office Action mailed March 21, 2005. Assignee submits that claims 1-8 are allowable for at least the reasons set forth above, and allowance of these claims is respectfully requested. The preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. If the Examiner believes there are any issues that can be resolved via a telephone conference, or there are any informalities that can be corrected by an Examiner's amendment, please call Geoffrey Gavin at (404) 815-6046.

Respectfully submitted,



Geoffrey K. Gavin
Registration No. 47,591

Date: May 24, 2005
KILPATRICK STOCKTON LLP
Suite 2800

USSN: 10/010,054
Amendment and Response to Office Action

1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 815-6046
Attorney Docket No.: I4060/249318 (IRC296)